

## REMARKS

Applicants thank the Examiner, Mr. Michael J. Araj, for his courtesies extended during the telephonic interview conducted on June 22, 2007, and for his assistance in advancing prosecution on the merits of the instant application during subsequent telephone discussions. During the formal telephonic interview, independent claim 12 was discussed. No agreement was reached with respect to the patentability of the claims of the instant application. The following comments clarify and expand on the substance of the formal telephonic interview, as well as the subsequent telephonic discussions.

Claims 12, 17-21 and 25-28 and 30 are pending in this application, with claim 12 being the only independent claim. Claim 29 has been canceled. Claim 12 has been amended to incorporate the subject matter of canceled claim 29. No new matter has been added. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 12, 17-21 and 25-30 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Publication Application No. 2002/0082604 (“*Abdelgany*”). Claims 12, 17, 21 and 26 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,569,898 (“*Hilburn*”). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 1 has been amended to recite, *inter alia*, “the receiving channel extending along an entire length of said first mounting part and having a longitudinal axis along the length between said first and second ends of said first side, said first mounting part further defining first and second intersecting slots therethrough in the region of said receiving channel, each of said first and second slots being arranged at an angle obliquely to the longitudinal axis of

the receiving channel, each of said first and second slots is configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an extent of the each of the first and second slots in a direction transverse to the longitudinal axis of the channel". No new matter has been added.

The Examiner (pg. 2-3 of the Office Action) asserts that:

Abdelgany et al. disclose a device that includes a first mounting part defining a receiving channel that has a longitudinal axis and the mounting part further defines at least one slot (See Fig. 7C) therethrough at an angle oblique to the longitudinal axis of the receiving channel. The first mounting part defines two intersecting slots in the region of the receiving channel each having an acute but different angles relative to the longitudinal axis of the receiving channel, where the second mounting part receivable on the first mounting part has at least one slot arranged....

...

Abdelgany et al. also discloses that each first and second mounting parts include guide elements positioning the parts relative to each other such that the slots and receiving channels face each other and are arranged congruently. These guide elements can be considered normal to the longitudinal axis of the receiving channel *if the longitudinal axis of the receiving channel is defined as perpendicular to the entire length of the device.*

*Also in looking at the slots in Fig. 7C it can be seen that these slots are configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an [extent of] each of the first and second slots in a direction transverse to the longitudinal axis.... (Emphasis Added)*

The amended independent claim 12 overcomes the Examiner's rejection in view of *Abdelgany*.

FIG. 7C of *Abdelgany* shows a device in which the slots would be arranged in a transverse (i.e., lateral) direction to the receiving channel when the cutting guide 14 is mounted to the main body 12 to provide a cutting guide-receiving structure 20, as shown in FIGS. 1-3. However, amended independent claim 12 recites "each of said first and second slots being arranged at an

angle obliquely to the longitudinal axis of the receiving channel” and “each of said first and second slots is configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an extent of the each of the first and second slots in a direction transverse to the longitudinal axis of the channel”. It is clear that the slots of *Abdelgany* are not arranged in this claimed manner but, rather, in a direction that is substantially transverse or, more particularly, laterally to the longitudinal axis of the receiving channel of the cutting guide shown therein. Therefore, *Abdelgany* fails to teach now amended claim 12 for at least this initial reason.

With specific reference to FIGS. 1 and 2 of *Abdelgany*, the receiving channel of the cutting guide shown therein is terminated by a wall or structure of the member 22 at one end. That is, when a bone is placed in the receiving channel, one end of the bone abuts this terminating wall or structure. Due to this configuration, the bone cannot extend completely through the cutting guide (see FIG. 2, for example).

In contrast, however, amended independent claim 12 recites “the receiving channel extending along an entire length of said first mounting part and having a longitudinal axis along the length between said first and second ends of said first side”. As a result of this claimed configuration, a bone is permitted to extend complete through the mounting part during displacement osteotomy. The arrangement provided in *Abdelgany* cannot permit a bone to extend in this manner. It is therefore clear that *Abdelgany* fails to teach amended claim 12 for at least this additional reason.

Moreover, the longitudinal direction of the device shown in *Abdelgany* extends in a direction parallel to the bone inserted in the receiving channel (see Fig. 2, for example). In contrast, the Examiner contends that the longitudinal direction could be considered to be across the channel.

However, construing the *Abdelgany* device in the manner asserted by the Examiner is contrary to the ordinary meaning of the term longitudinal, i.e., extending in the direction of the length of an article or running lengthwise. In *Abdelgany*, the length of the device is therefore defined by the receiving channel in which the bone is placed. When the cutting guide 14 is thus mounted to the main body 12 to provide a cutting guide-receiving structure 20, as shown in FIGS. 1-3, the slots of *Abdelgany* are not arranged longitudinally but, rather, they are arranged laterally. Therefore, the limitation of “each of said first and second slots is configured so that an extent of each of said first and second slots in a direction of the longitudinal axis of the channel is greater than an extent of the each of the first and second slots in a direction transverse to the longitudinal axis of the channel”, as recited in now amended independent claim 12 cannot be met by the device of *Abdelgany*. Independent claim 12 is therefore patentable over *Abdelgany* for at least this additional reason.

In view of the foregoing, and reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) is therefore in order, and a notice to that effect is respectfully requested.

The Examiner (pg. 5 of the Office Action) asserts that:

Hilburn discloses a device that includes a first mounting part (12) defining a receiving channel that has a longitudinal axis and the mounting part further defines at least one slot (27) therethrough at an angle oblique to the longitudinal axis of the receiving channel (see Figure 2 below) having a V-shaped cross section.

Amended independent claim 12 is also allowable over *Hilburn*.

*Hilburn* discloses “a fixture for retaining the ends of two pipe sections together during welding” (see Abstract). In particular, *Hilburn* (col. 1, lines 45-47) states that “the fixture 10 of this invention comprises a lower clamp member 11 and an upper clamp member 12 which are brought together to hold the pipe firmly”. *Hilburn* (col. 2, lines 11-13) further describes that both clamp members or angle irons are preferably recessed at the center on both sides by slots or

recesses 26 and 27. As shown in FIG. 1, each of the lower member 11 and upper member 12 has only one recess or slot.


However, independent claim 12 recites "first mounting part further defining first and second intersecting slots therethrough in the region of said receiving channel, each of said first and second slots being arranged at an angle substantially obliquely to the longitudinal axis of the receiving channel". That is, independent claim 12 requires the first mounting part to have more than one slot. *Hilburn* fails to teach or suggest this limitation, since *Hilburn* (FIG. 1) clearly teaches that one slot 26 is arranged on the lower member 11 and another slot 27 is arranged on the upper member 12, and each of these members do not have more than one slot. Therefore, independent claim 12 is patentable over *Hilburn* for at least this additional reason.

In view of the foregoing, independent claim 12 is patentable over *Hilburn*. Reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) is therefore in order, and a notice to that effect is respectfully requested.

In view of the patentability of independent claim 12, for the reasons set forth above, dependent claims 17-21 and 25-28 and 30 are all patentable over the prior art.

Based on the foregoing amendments and remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested. Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By   
Alfred W. Froeblich  
Reg. No. 38,887  
551 Fifth Avenue, Suite 1210  
New York, New York 10176  
(212) 687-2770